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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/319,411 10/06/94 NIELSEN

P 1M ISIS1158

HM12/0418

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EXAMINER

MARSCHER, A

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

04/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
08/319,411

Applicant(s)

Nielsen et al.

Examiner
Ardin Marschel

Group Art Unit
1631



☒ Responsive to communication(s) filed on Jan 31, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1, 5, 8-10, 12, 13, 15, 20, 22-24, 30-33, 37, and 39-50 is/are pending in the application

~~PTO-220~~ ☒ Claim(s) 2-4, 6, 7, 11, 14, 16-19, 21, 25-29, 34-36, and 38 have been ^{cancelled,} ~~is/are~~ ^{is/are} ~~not under consideration~~

☒ Claim(s) 12, 13, 39, 41, 44, 46, 48, and 49 is/are allowed.

☒ Claim(s) 1, 5, 8-10, 15, 20, 22-24, 30-33, 37, 40, 42, 43, 45, 47, and 50 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

Applicants' arguments, filed 1/31/00, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Regarding the amendment, filed 1/31/00, the amending in the first lines of claims 12 and 13 was confusing in that there was not found any 38 to replace. In order to expedite prosecution, it has been assumed that the dependence from claim 11 is meant to be replaced with 39 in these claims. If applicants did not wish these claims to depend from claim 39 they should correct this in their next response via further amending. Also, the deletion in claim 32, second line, was assumed to delete "R¹² is a conjugate" even though the requested deletion cited R¹³, whereas claim 32 previously contained R¹².

Claims 30-33 and 47 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47, line 37, "R3" lacks antecedent basis due to

presumably the lack of correct superscripting. This unclarity is also present in claim 30, 8th line from the end of claim 30. Applicants argue that all of the citations of this moiety have the same superscripting. This conflicts with the actual content of the above listed claims. Said claim 47 and 30 citation clearly contain R3 without any superscripting whereas chemical structures in these claims contain R³ clearly with superscripting which is therefore conflicting in designation. This rejection is maintained and reiterated from the previous office action, mailed 8/27/99.

Claim 33 is rejected, as discussed below, under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 33 requires R¹³ to be a conjugate which is already a limitation of claim 30 from which claim 33 depends. Applicants have amended claim 32 and not 33 and thus this rejection still is deemed proper. This rejection is maintained and reiterated from the previous office action, mailed 8/27/99.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1, 8, 15, 20, 22-24, 37, 40, 42, 45, and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomson et al. (WO 93/12129); recently cited of record.

This rejection is maintained and reiterated from the previous office action, mailed 8/27/99. Applicants argue that the priority document, PCT/US92/01219 discloses the pertinent disclosure of Thompson et al. and that this predates Thompson et al. In response, consideration of the citations pointed to by applicants at page 17 and claim 1 has failed to reveal any disclosure in said priority document of steroidal Q entities as given in Thompson et al. Additionally, consideration of said priority document revealed that amino termini therein are disclosed as blocked and not of the amino type as given as an option in Thompson et al. besides the steroidal terminus upon which this rejection is based.

Claims 1, 8, 15, 20, 37, and 40 are rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Manoharan et al. (P/N 5,834,607), taken in view of Nielsen et al. [Science 254:1497(1991); already of record].

This rejection is reiterated and maintained from the previous office action, mailed 8/27/99, as not argued other than regarding submitting a future Declaration.

The above applied Manoharan et al. reference has a common inventor and assignee with the instant invention. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). The above rejection under 35 U.S.C. 103(a) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another", or by a showing of a date of invention for the instant application of any unclaimed subject matter prior to the effective U.S. filing date of the reference under 37 CFR 1.131. This paragraph also applies to that portion of the below rejection based on the combination of references that includes Manoharan et al.

Claims 1, 5, 8-10, 15, 20, 22-24, 30-33, 37, 40, 42, 43, 45, and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomson et al. (WO 93/12129); recently cited of record; or Manoharan et al. (P/N 5,834,607), taken in view of Nielsen et al. [Science 254:1497(1991); already of record]; either

set of references taken in view of Ward et al. (P/n 4,711,955).

This rejection is reiterated and maintained from the previous office action, mailed 8/27/99, as not argued other than regarding submitting a future Declaration or that Thompson et al. is not prior art. The future Declaration has not been received in the file as of the mailing of this action and Thompson et al. is still deemed prior art as discussed above due to a lack of the priority document overcoming rejections based on Thompson et al.

Claims 12, 13, 39, 41, 44, 46, 48, and 49 are allowed.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M.

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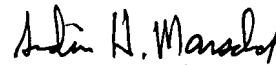
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to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technical Center receptionist whose telephone number is (703) 308-0196.

April 17, 2000


ARDIN H. MARSCHEL
PRIMARY EXAMINER